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10/595,335	04/10/2006	Martin Krohn	3712036.00707	7681
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K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER				
GWARTNEY, ELIZABETH A				
ART UNIT		PAPER NUMBER		
1781				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary

Application No.

10/595,335

Applicant(s)

KROHN ET AL.

Examiner

ELIZABETH GWARTNEY

Art Unit

1781

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Amendment filed 7 December 2010 has been entered. Claims 1-6 and 8-20 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-6 and 8-20** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 9, 10 and 15 have been amended to recite "heat resistant fat-based confectionery product having a maximum dimension no greater than 5 cm." While there is support in the specification at paragraph [0023] stating that the size of the fat-based confectionery "is such that the maximum dimension is **not usually** greater than 5 cm," there is no support for stating that the dimension **is not** greater than 5 cm. Please note that the term "usually" does not serve to clarify the issue.

5. **Claims 1-6 and 8-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 9, 10 and 15, the recitation "having a maximum dimension no greater than 5 cm" renders the claim indefinite because it is not clear what dimension is encompassed by a **maximum dimension**.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. **Claims 1-4, 6, 8 and 16-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Woznicki et al. (US 4,802,924).

Regarding **claims 1-4, 6 and 18-19**, Woznicki et al. disclose a film coated chocolate product wherein the film coating comprises a cellulosic polymer, polydextrose, a plasticizer, and lecithin (C2/L32-68). Woznicki et al. also disclose that the film coating comprise titanium dioxide, i.e. colorant and mineral (C2/L43-45).

While Woznicki et al. disclose a film coated chocolate product, the reference does not explicitly disclose that thickness of the film coating is 1 micrometer to 1 millimeter or that the film coating is 0.01% to 10%, 0.5 to 6%, or 2 to 5% by weight of the fat-based confectionery product. As coating smoothness and shininess are variables that can be modified, among others, by adjusting the film thickness and the amount of film coating, the precise film thickness and amount of film coating on the fat-based confectionery product would have been considered result effective variables by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed film thickness and amount of film coating cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have adjusted, by routine processing, the film thickness and amount of film coating on the chocolate product of Woznicki et al. to obtain the desired coating shininess and smoothness (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been

held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

Given Woznicki et al. disclose a film coated chocolate product identical to that presently claimed, it is clear that it would intrinsically be heat shape stable and heat resistant.

Given Woznicki et al. disclose a chocolate product wherein the chocolate product is chocolate pieces of candy (C2/L67), it necessarily follows that the chocolate product would have a maximum dimension not greater than 5 cm. Further, It would have been obvious to one of ordinary skill in the art at the time of the invention to varied the maximum dimension of the chocolate pieces, since such a modification would have involved a mere change in the size. Change in size is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claim invention is significant. See In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04[R-1].

Regarding **claim 8**, Woznicki et al. disclose all of the claim limitations as set forth above and that the product is a chocolate product coated with a film comprising lecithin (C2/L49,64-68).

Woznicki et al. does not explicitly disclose that the chocolate product is less than 15 millimeters in width. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the thickness of the chocolate product since such a modification would have involved a mere change in the size. Change in size is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claim invention is significant. See In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); In re Rinehart, 531 F.2d 1048, 189

USPQ 143 (CCPA 1976); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04[R-1].

Regarding **claim 16**, Woznicki et al. disclose all of the claim limitations as set forth above and that the film forming coating agent is polydextrose and a cellulosic polymer selected from the group consisting of hydroxypropyl methylcellulose or hydroxypropyl cellulose (C2/L32-40).

Regarding **claim 17**, Woznicki et al. disclose all of the claim limitations as set forth above and that the plasticizer is chosen from the group consisting of polyethylene glycol and propylene glycol (C2/L41-42).

10. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Woznicki et al. (US 4,802,924) in view of Steffenino et al. (US 6,274,162).

Regarding **claim 5**, Woznicki et al. disclose all of the claim limitations as set forth above and that the film coating comprises colorant (C2/L43-48). However, Woznicki et al. does not disclose that the film coating comprises flavorant.

Steffenino et al. teach a film coated confectionery product wherein the film coating comprises hydroxyethyl cellulose, a plasticizer, a colorant and a flavorant (Abstract). Steffenino et al. teach that flavorant is used primarily for taste and/or odor masking (C3/L38-39).

Woznicki et al. and Steffenino et al. are combinable because they are concerned with the same field of endeavor, namely, film-coated confectionery products. It would have been obvious to one of ordinary skill in the art at the time of the invention to have added flavorant, as taught

by Steffenino et al., to the film coating of Woznicki et al. for the purpose of adding flavor and masking off-flavors.

11. **Claims 9-10, 13, 15 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooking Light ("Chewy Chocolate-Chip Cookies") in view of Woznicki et al. (US 4,802,924).

Regarding claims 9-10, 13, 15 and 20, Cooking Light discloses chocolate chip cookies comprising chocolate chips (i.e. fat-based confectionery product) and flour (p.1/Title, Ingredients). Cooking Light also discloses a method to produce the cookies by using chocolate chips (p.1/entire recipe). Cooking Light does not disclose that the confectionery product is heat shape stable, heat resistant or comprises a film coating having a thickness from 1 micrometer to 1 millimeter.

Woznicki et al. teach a chocolate film coated with polydextrose, cellulosic polymer, plasticizer, lecithin, and titanium dioxide, i.e. mineral and colorant (Abstract, C2/L33-68).

While Woznicki et al. teach a film coated chocolate product, the reference does not explicitly disclose that thickness of the film coating is 1 micrometer to 1 millimeter. As coating smoothness and shininess are variables that can be modified, among others, by adjusting the film thickness, the precise film thickness would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed film thickness cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have adjusted, by routine processing, the film thickness on the chocolate product of Woznicki et al. to obtain the desired coating

shininess and smoothness (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

Given that Woznicki et al. teach a film coated chocolate identical to that presently claimed, it is clear that it would intrinsically be heat shape stable and heat resistant.

Given Woznicki et al. disclose a chocolate product wherein the chocolate product is chocolate pieces of candy (C2/L67), it necessarily follows that the chocolate product would have a maximum dimension not greater than 5 cm. Further, It would have been obvious to one of ordinary skill in the art at the time of the invention to varied the maximum dimension of the chocolate pieces, since such a modification would have involved a mere change in the size. Change in size is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claim invention is significant. See In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04[R-1].

Cooking Light and Woznicki et al. are combinable because they are concerned with the same field of endeavor, namely, confectionery products. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the film-coated chocolate, as taught by Woznicki et al. in the chocolate chip cookies of Cooking Light because doing so would amount to nothing more than the use of a known chocolate confectionery for it use in a known environment to accomplish entirely expected results. Further, by doing so the shape of the chocolate would remain intact and more colorful cookies would be produced.

Given that Woznicki et al. disclose a film coated chocolate identical to that presently claimed, it is clear that intrinsically the color from the coating would not bleed into or onto the food product.

12. **Claims 10-12 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bon Appétit ("Black Forest Fudge") in view of Woznicki et al. (US 4,802,924).

Regarding **claims 10-11**, Bon Appétit discloses fudge comprising chocolate chips sprinkled on top (i.e. fat-based confectionery product).

Bon Appétit does not disclose that the confectionery product is heat shape stable, heat resistant or comprises a film coating.

Woznicki et al. teach a chocolate film coated with polydextrose, cellulosic polymer, plasticizer, lecithin, and colorant (Abstract, C2/L33-68). Given that Woznicki et al. teach a film coated chocolate identical to that presently claimed, it is clear that it would intrinsically be heat shape stable and heat resistant.

While Woznicki et al. teach a film coated chocolate product, the reference does not explicitly disclose that thickness of the film coating is 1 micrometer to 1 millimeter. As coating smoothness and shininess are variables that can be modified, among others, by adjusting the film thickness, the precise film thickness would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed film thickness cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have adjusted, by routine processing, the film thickness on the chocolate product of Woznicki et al. to obtain the desired coating

shininess and smoothness (In re Boesch, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (In re Aller, 105 USPQ 223).

Given Woznicki et al. disclose a chocolate product wherein the chocolate product is chocolate pieces of candy (C2/L67), it necessarily follows that the chocolate product would have a maximum dimension not greater than 5 cm. Further, It would have been obvious to one of ordinary skill in the art at the time of the invention to varied the maximum dimension of the chocolate pieces, since such a modification would have involved a mere change in the size. Change in size is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claim invention is significant. See In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04[R-1].

Bon Appétit and Woznicki et al. are combinable because they are concerned with the same field of endeavor, namely, confectionery products. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the film-coated chocolate, as taught by Woznicki et al. sprinkled on top of the fudge of Bon Appétit because doing so would amount to nothing more than the use of a known chocolate confectionery for it use in a known environment to accomplish entirely expected results. Further, by doing so the shape of the chocolate would remain intact and more colorful fudge would be produced.

Regarding claim 12, modified Bon Appétit disclose all of the claim limitations as set forth above but the reference does not explicitly disclose that the food product has a uniform

texture. Given that Bon Appétit discloses stirring the mixture vigorously (p.1/Preparation, paragraph 2) if necessarily follows that the fudge would have a uniform texture.

Regarding claim 14, modified Bon Appétit discloses all of the claim limitations as set forth above. Woznicki et al. disclose that the film coating comprises lecithin (C2/L49). However, there is no disclosure that the chocolate pieces are less than 15 millimeters in width. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the thickness of the chocolate product since such a modification would have involved a mere change in the size. Change in size is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claim invention is significant. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04[R-1].

Response to Arguments

13. Applicants' arguments filed 7 December 2010 have been fully considered but they are not persuasive.

Applicants submit that "Woznicki is entirely directed toward providing a film coating on a pharmaceutical tablet, food, confectionery from and the like by coating them with polydextrose." Applicants find that "Woznicki fails to mention the presence of any starches present in a film, let alone the modified starches required, in part, by the present claims."

While the present claims require a film coating comprising a coating agent selected from the group consisting of a cellulose-based material, modified starch, dextrans, maltodextrin, carrageenan, shellac, whey protein, alcohol-based coating material, other water-based film

former and mixtures thereof, there is no requirement that the coating agent be a modified starch. In this case, Woznicki disclose a film coating comprising polydextrose and a cellulose-based material such as hydroxypropyl methylcellulose or hydroxypropyl cellulose which clearly meets the limitations of claims 2 and 16.

Applicants argue that Woznicki et al. “fails to mention that the film coating has a certain thickness, let alone a thickness of from 1 micrometer to 1 millimeter.” Applicants disagree that the film thickness would have been considered a result effective variable and submit that the thickness of the film coating would be understood as providing heat stability and heat resistance to the confectionery product underlying the film coating.

First, given Woznicki et al. disclose a film coated chocolate product wherein the product is coated in a substantially similar same manner as disclosed in the present invention, i.e. by spraying (C3/L31-33/Example 1, C4/L55-57/Example 5), it necessarily follows that the film thickness would intrinsically fall within the range as presently claimed. Second, while applicants find that film thickness is not a result effective variable and provide that film thickness provides heat stability and heat resistance, there is nothing in the record that demonstrates these properties are unexpected.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH GWARTNEY whose telephone number is (571)270-3874. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./
Examiner, Art Unit 1781

/Keith D. Hendricks/
Supervisory Patent Examiner, Art Unit 1781